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Art Group 2133	571/273-8300	571/272-4100

RE: Application No. 10/087,130
In re application of: Nikki M. Bruner, et al.
Assignee: SEAGATE TECHNOLOGY LLC
Dkt. No.: P1569US01

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

P1569US01

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37 CFR §1.8(a) on August 8, 2006

Signature Diana C. Anderson

Typed or printed name Diana C. Anderson

Application Number

10/087,130

Filed

February 28, 2002

First Named Inventor

Nikki M. Bruner

Art Unit

2133

Examiner

Joseph D. Torres

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 39,297

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Randall K. McCarthy
Signature

Randall K. McCarthy
Typed or printed name

(405) 232-0631
Telephone number

8/8/06
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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PATENT
Dkt. P1569US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nikki M. Bruner and John E. Young
Assignee: SEAGATE TECHNOLOGY LLC
Application No.: 10/087,130 Group No.: 2133
Filed: February 28, 2002 Examiner: Joseph Torres
For: EMULATION SYSTEM FOR EVALUATING DIGITAL DATA CHANNEL
CONFIGURATIONS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Despite the extended prosecution under an RCE in this case, the Panel is now faced with the task of determining whether the Examiner fundamentally has factually supported a prima facie case of obviousness. Applicant prays that the Panel's objective review will conclude that there are unresolved issues in this case that are not bona fide matters for appeal, but are rather issues that must be resolved before this case is in condition for appeal.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

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IT IS CLEAR ERROR THAT THE EXAMINATION RESULTING IN MAINTAINING
THE FINAL REJECTION IS INCOMPLETE

The Advisory Action of 7/24/2006 consists entirely of erroneous statements.

Particularly, addressed in its entirety:

The Examiner asserts that in the last Office Action, claim 29 was not written in a manner to distinguish preamble from limitations and appeared to be a single preamble with no limitations. Note: a preamble is not normally given patentable weight.
(Advisory Action)

Applicant has pointed out that the Examiner's characterization of claim 29 as merely a preamble is erroneous because it recites a *circuit* with functional limitations thereof, and because it does not recite multiple features (see Applicant's Response of 7/10/2006, pg. 9; Applicant's Response of 3/8/2006, ppg. 9-10). Nevertheless, Applicant attempted to amend claim 29 to advance the merits. However, it is clearly reversible error that the Examiner refused to enter the amendment without comment as to why it does not obviate the objection.

The Examiner made the assumption that the Applicant was attempting to claim the same matter as claim 28 for the sole purpose of advancing prosecution.
(Advisory Action)

Applicant has pointed out that the Examiner's rejecting claims 28 and 29 on the same basis, where claim 28 is a means-plus-function claim under Section 112 paragraph six and claim 29 is not, is clearly reversible error (see Applicant's Response of 7/10/2006, pg. 9; Applicant's Response of 3/8/2006, ppg. 17-19).

The Applicant amended claim 28 in such a manner that was not anticipated by the Examiner....
(Advisory Action)

Applicant has explained why the Examiner's suggested "corresponding" language is ambiguous and mischaracterizes the embodiments as claimed (see Applicant's Response of 7/10/2006, pg. 10). Applicant has also requested (but not been granted) telephone interviews in five separate filings in attempts to resolve the Examiner's concerns. It is

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clearly reversible error to base a final rejection just on the amendment being "unanticipated," while not substantiating a rejection for it.

and the Applicant admits in the Applicant's response that claim 29 requires further consideration. The Examiner concurs.
(Advisory Action)

Applicant has made no such admission whatsoever. Actually, Applicant amended claim 29 to add a ":" after the term *comprising* and indenting the rest of the language, and pointed out that the rejection of claim 29 is otherwise erroneous for lacking a *prima facie* case of obviousness. It is clearly reversible error to maintain the final rejection on the basis of fabricating an admission where none exists in the record.

Accordingly, for these reasons the examination resulting in maintaining the final rejection is incomplete with regard to the Examiner's obligation to consider the patentability of the invention as claimed. 37 CFR 1.104(a)(1). Also, because the final rejections are lacking a *prima facie* basis, the examination does not provide reasons for the rejections that are useful in aiding Applicant to judge the propriety of continuing the prosecution. 37 CFR 1.104(a)(2).

Applicant now prays the Panel will reopen the merits so that these issues can be resolved in order to place the case in condition for appeal.

IT IS CLEAR ERROR THAT THE EXAMINER HAS FAILED TO FACTUALLY SUPPORT A *PRIMA FACIE CASE* OF OBVIOUSNESS OF CLAIMS 1, 28, 29, AND 30 BY NOT SUBSTANTIATING EVIDENCE THAT THE CITED REFERENCES TEACH OR SUGGEST ALL THE FEATURES OF THE REJECTED CLAIMS

One requirement for factually supporting a *prima facie* case of obviousness is that the cited reference (or references when combined) must teach or suggest all the recited features of the rejected claim. MPEP 2142. Applicant has pointed out that claims 1, 29, and 30 recite language to the effect of "characterizing stored data in a selected one of a plurality of different digital configurations," and claim 28 recites *means for predicting* covering the disclosed structure and equivalents thereof for performing that recited function (see Applicant's Response of 7/10/2006, ppg. 11-18; Applicant's Response of 3/8/2006, ppg. 10-21). The Examiner has not rebutted Applicant's argument.

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The legal concept of *prima facie* obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to go forward submitting evidence of nonobviousness (MPEP 2142). Directly applied to this case, Applicant should not be burdened with the delay and expense of proceeding to appeal where the Examiner has not met the threshold requirement of factually supporting a *prima facie* case of obviousness.

Obviousness under Section 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). The Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's position that a *prima facie* case of obviousness has been made. *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

The Panel will find an unresolved factual issue in that the Examiner has provided no evidence whatsoever that the cited references teach or suggest all the recited features of the independent claims. This leads to an unresolved legal issue that the Applicant should not be forced to go forward with appeal in the absence of a *prima facie* case of obviousness. Applicant now prays for an objective review of the facts of this case and a conclusion that the unresolved legal and factual issues must be resolved before this case should proceed to appeal.

IT IS CLEAR ERROR THAT THE EXAMINER HAS FAILED TO FACTUALLY SUPPORT A *PRIMA FACIE* CASE OF OBVIOUSNESS OF CLAIMS 1, 28, 29, AND 30 BY NOT SUBSTANTIATING EVIDENCE MOTIVATING ONE SKILLED IN THE ART TO MODIFY AND COMBINE THE CITED REFERENCES TO ARRIVE AT THE PRESENT INVENTION AS CLAIMED BY THE REJECTED CLAIMS

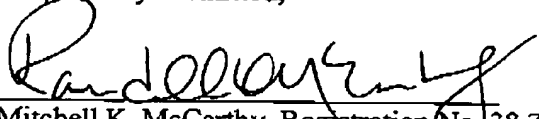
Notwithstanding the above legal and factual issues, another requirement for factually supporting a *prima facie* case of obviousness is that the Examiner must point to some suggestion or motivation, either in the references themselves or in the knowledge of

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the skilled artisan, to modify and/or combine the cited references to arrive at the invention as claimed. This motivation must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant has pointed out that the Examiner has provided no evidentiary basis whatsoever motivating the skilled artisan to combine and modify the cited references (see Applicant's Response of 7/10/2006, ppg. 10-18; Applicant's Response of 3/8/2006, ppg. 10-21). By providing no evidentiary basis whatsoever motivating the skilled artisan to modify and combine the cited references, the Examiner blatantly ignores his obligation to factually support a *prima facie* case of obviousness.

For the legal reasons discussed above, the Panel will find an unresolved factual issue in that the Examiner has provided no evidence whatsoever that would motivate a skilled artisan to modify and combine the cited references to arrive at the invention recited by the language of the independent claims. This leads to an unresolved legal issue that the Applicant should not be forced to go forward with appeal in the absence of a *prima facie* case of obviousness. Applicant now prays for an objective review of the facts of this case and a conclusion that the unresolved legal and factual issues must be resolved before this case should proceed to appeal.

Respectfully submitted,

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